

Stern et al.

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Serial No. 10/063,998

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Confirmation No. 7196**AUG 09 2006**Patent
Attorney Docket No. GEMS8081.124**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Stern et al.
Serial No. : 10/063,998
Filed : June 3, 2002
For : Method and Apparatus of Cross-Pollinating a Post to Computerized
Bulletin Boards
Group Art No. : 2161
Examiner : Cindy Nguyen

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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/Stephen J. Gardner/
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Commissioner for Patents
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PRE-APPEAL REQUEST FOR REVIEW

Dear Sir:

Responsive to the Advisory Action mailed August 3, 2006, Applicant requests a pre-appeal conference to review the final rejection in the above-identified application. In furtherance of such review, Applicant presents the following remarks. This request is being filed with a Notice of Appeal and without any amendments.

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REMARK AUG 09 2006

Claims 1-22 are pending in the present application. In the Final Office Action mailed May 9, 2006, the Examiner rejected claims 1, 5, 8-11, 15, 16, and 22 under 35 U.S.C. §103(a) as being unpatentable over Smith et al (USP 6,594,673) in view of San Andres et al. (USP 5,956,489). The Examiner next rejected claims 2-4, 6, 7, 12, 14, 17-21 under 35 U.S.C. §103(a) as being unpatentable over Smith et al. in view of Knight et al. (USP 6,721,748).

This request is believed proper because the Examiner's grounds of rejection for claims 1, 5, 8-11, 15, 16, and 22 is unclear and should not be maintained as final. All currently pending rejections are additionally defective because the Examiner has never addressed how the primary reference, Smith et al., teaches the elements of the claims. The Examiner has only discussed how the system of Smith et al. operates, but not how such system constitutes the claimed invention. Since this request does not present a mere reference interpretation issue, but a complete disregard for the claim elements, Applicant requests that the Panel reverse the present rejections and remove the application from finality.

IMPROPER FINALITY AND PROCEDURAL DEFECTS

In the Final Office Action, the Examiner rejected claims 1, 5, 8-11, 15, 16, and 22 as being obvious in view of two references, despite not offering any motivation to combine these references. The Examiner acknowledged that "obviousness can only be established ... where there is some teaching, suggestion, or motivation" to combine or modify references, but then stated that "there is no need [to establish] the suggestion or motivation to do so" with respect to the rejection of claims 1, 5, 8-11, 15, 16, and 22 under § 103 because one reference teaches all elements thereof. *Final Office Action*, 05/09/06, p. 2.

In addition to the lack of a motivation to combine, Applicant has also pointed out that the rejection of claims 1, 5, 8-11, 15, 16, and 22 was improper because the Examiner cited portions of only one of the references (Smith et al.) as "teach[ing] all the limitations in claims 1, 5, 8-11, 15, 16 and 22." *Id.* (Emphasis added.) In contrast, in the Office Actions dated July 28, 2005 and April 7, 2005, the Examiner affirmatively took the opposite position - that "Smith didn't disclose: automatically placing a copy of the post on each of the one or more other computerized bulletin boards related to the at least one topic of relevance," an expressly recited element of claim 1. *Office Action*, 07/28/05, p. 3; *Office Action*, 04/07/05, p. 3. As such, Applicant requested, at a minimum, that the Examiner remove the finality of the rejection and requested a clarification on whether the rejection was grounded in anticipation or a combination of references.

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In the ensuing Advisory Action mailed August 3, 2006, the Examiner admitted that the rejection under § 103(a) was "defective" and stated that the "Examiner believes that Smith et al. anticipates the claims under [a] 102 rejection." *Advisory Action*, 08/03/2006, p.2 (emphasis added). In effect, it seems that the Examiner is asserting a new ground of rejection (§ 102) in an Advisory Action, while apparently maintaining the finality of a recognizably defective rejection (§ 103).

It is now even more unclear to Applicant as to which rejection is really being applied - a § 102 rejection or a § 103 rejection. In addition, how the Examiner still believes that finality is proper given the statements in the Advisory Action is baffling. If the § 103 rejection is still being applied in finality, the Examiner is maintaining the finality of an admittedly defective rejection. *See* MPEP § 2143.01 (a *prima facie* case of obviousness requires some suggestion or motivation to modify the references). If a § 102 rejection is now being applied, the Examiner has made a rejection final without giving Applicant an opportunity to respond. According to the MPEP, "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement." MPEP § 706.07(a). Since Applicant made no amendments nor submitted any new references, the Examiner's statements in the Advisory Action are in clear contravention of the MPEP.

FUNDAMENTAL DEFECTS AND THE ART OF RECORD

In addition, Applicant notes that the rejection is fundamentally defective because the Examiner has never identified teaching or suggestion in the art of record to show that all elements of the rejected claims are anticipated or obvious. The Examiner has continued to copy the same poorly worded language in multiple correspondence about how the system of Smith et al. operates, without attempting to cure the deficiencies of the rejections or rebut Applicant's arguments.

In particular, claim 1 calls for "automatically determining one or more other computerized bulletin boards related to the at least one topic of relevance" and "automatically placing a copy of the post on each of the one or more other computerized bulletin boards related to the at least one topic of relevance." In response to Applicant's arguments that the Examiner has not shown all elements to be present in Smith et al., the Examiner has provided the following quotation several times:

Automatically placing a copy of the post on other computerized bulletin boards as cross-posts between a core newsgroup and a newsgroup corresponds to the relative strength of the link between the two groups, cross posts simply means a

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single posting is post to Usenet so that it is destined to two or more newsgroups therefore automatically placing a copy of the post on each other newsgroup.
Final Office Action, 05/09/06, p. 4.

In other words, the Examiner has contended that Smith et al. determines which bulletin boards are related to a topic of relevance in a post by measuring the number of cross-posts between "groups" as an indication of the "similarities in the subject matter or topics covered by the two groups." See *Advisory Action, 08/03/2006, p. 2.* By making the foregoing circular contentions, the Examiner has not rebutted Applicant's explanation that nowhere does Smith et al. teach the claimed elements.

The Examiner has never cited any portion of Smith et al. that teaches determining relation of a bulletin board to a topic (as opposed to another bulletin board) or the actual act of cross-posting posts. The only citations the Examiner has provided are inapposite. See, e.g. *Final Office Action, 05/09/2006, p. 3.*

In addition, the Examiner has repeatedly failed to recognize that determining the relevance of a bulletin board for the purpose of cross-posting by examining the number of cross-posts is circular. If the Examiner's contention were the case, new cross-posts would only be posted where other cross-posts already exist, and not to relevant bulletin boards having no preexisting cross-posts. Smith et al. teaches the depiction of newsgroups 102 related to a selected newsgroup 108, wherein the status of "related" depends upon the preexistence of cross-posts. Col. 6, ll. 18-21. Thus, the method of Smith et al. could not be used to determine which bulletin boards or newsgroups are related to a topic, for purposes of cross-posting, since Smith et al. relies on cross-posts to determine relevance. Without the preexistence of cross-posts, the cited embodiment of Smith et al. would have no measure for determining relation - whether to a topic or between newsgroups.

Likewise, the same deficiencies are present with respect to the rejection of claim 10. Applicant has shown the Examiner that Smith et al. does not teach a determination of "one or more specific computerized bulletin boards dedicated to the one or more specific topics of relevance," nor the actual act of cross-posting thereto. Yet, the Examiner has never responded to or rebutted Applicant's arguments: The rejection of claim 10 has been, and still is, deficient in terms of showing all elements of claim 10 to be present in the prior art.

Claim 22 calls for "means to determine at least one of a specific topic of interest and a general topic of interest of the user post" and "means to automatically place a copy of the user post on each content-specific bulletin board to which the post relates and on the content-general bulletin board." As set forth above, the Examiner has never cited any teaching or suggestion in

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the prior art for determining bulletin boards which relate to a topic of a post for the purpose of cross-posting such post. In addition, since there is no disclosure of the act of posting in Smith et al., the Examiner has also not shown copying the user post "without copying all other user posts of the set of content-specific bulletin boards" to be present in the prior art. As such, the rejection of claim 22 is deficient.

The Examiner's rejection of claim 17 as being obvious in view of Smith et al. and Knight et al. is also fundamentally deficient. The Examiner indicated that Smith et al. teaches all the elements of claim 17 except for "scanning the body of the post and determining another topic of interest to which the post is relevant," as for which the Examiner cited Knight et al.

As discussed above, the Examiner has never shown that Smith et al. teaches or suggests placing posts on bulletin boards dedicated to a topic of interest, let alone automatically placing a copy of the post on another bulletin board related to another topic of interest. For the same reasons, the Examiner has not shown that Smith et al. teaches buttons of a GUI "wherein each button is associated with a topic of interest." Smith et al. specifically sets forth the criteria by which it determines relationships between newsgroups, threads, and persons, none of which include topics from the body of a post. Col. 6, ll. 18-21; col. 6, ll. 36-38, 48-51; col. 7, ll. 9-10; col. 7, ll. 2-5; Fig. 6.

The cited portion of Knight et al. reveals that a key feature thereof is providing capability for a user to search existing posts of bulletin boards. Col. 5, ll. 37-42. The system monitors user posts, and "automatically downloads" messages related to a user query input. Col. 6, ll. 32-35. Thus, the Examiner has not shown that Knight et al. teaches "placing the post on a computerized bulletin board dedicated to the topic of interest" or "automatically placing a copy of the post on another computerized bulletin board related to the another topic of interest." Accordingly, the rejection of claim 17 is deficient since the cited references do not teach or suggest each and every limitation of claim 17, individually or in combination.

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In light of the foregoing, Applicant respectfully believes that the pending final rejections are defective in terms of finality as well as sustainability. Withdrawal of all pending rejections is therefore respectfully requested. Applicant appreciates the Panel's consideration of this Request and respectfully requests timely issuance of a Notice of Allowance.

Respectfully submitted,

/Timothy J. Ziolkowski/

Timothy J. Ziolkowski
Registration No. 38,368
Direct Dial 262-376-5139
tjz@zpspatents.com

Respectfully submitted,

/Kent L. Baker/

Kent L. Baker
Registration No. 52,584
Phone 262-376-5170 ext. 12
klb@zpspatents.com

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P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170